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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,145	12/30/2005	Dung Dao Viet	OVL0003US	4566

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EXAMINER
HUANG, CHENG YUAN

ART UNIT	PAPER NUMBER
1787	

NOTIFICATION DATE	DELIVERY MODE
09/13/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/563,145	VIET ET AL.	
	Examiner	Art Unit	
	CHENG HUANG	1787	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 August 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *1-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02 August 2010 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 26 recites the limitation "the first non-curable coating" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

> such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (U.S. Patent No. 4,863,782) in view of Eby et al. (U.S. Patent No. 6,753,066) and Schmidle et al. (U.S. Patent No. 4,491,616).

8. Regarding claims 21, 24, and 26, Wang et al. teaches a surface covering (See Title) comprising a substrate (felt layer 60, col. 9, lines 27-28), a plastic layer overlaying the substrate (foamed layer 62, col. 9, line 29-30), an ink printed in a pattern or design on said plastic layer (printing design 64, col. 9, line 41, Fig. 10), and a non curable coating made from plastisol (col. 9, lines 9-16 and 62-68) given that it is clear the second layer 66 (col. 9, line 65) is made from PVC plastisol similar to wearlayer 24 (col. 9, lines 14-16) given that second layer 66 is also a transparent wearlayer (col. 9, lines 66-67) similar to wearlayer 24 (col. 9, lines 112-13) overlaying the plastic layer and the ink (second layer 66, col. 9, lines 64-65, Fig. 10). A layer is considered to be a coating.

9. Wang et al. fails to teach a cured coating overlaying the non-curable coating.

10. However, Eby et al. teaches a surface covering (See Title) wherein a cured coating overlaying an ink is mechanically embossed (col. 3, lines 46-62 and 35-39).

11. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a cured coating overlaying the non-curable coating of Wang et al. to further protect underlying layers.

12. Wang et al. fails to teach an ink containing a photoinitiator or that the plastic layer is gelled.

13. However, Schmidle et al. teaches a surface covering (See Title) comprising an ink containing a photoinitiator (col. 9, lines 3-8, col. 12, lines 1-4, col. 3, lines 54-62).

14. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a photoinitiator in the ink of Wang et al. to create surface areas with an embossed flat, dead, or dull mat finish or texture (Schmidle et al, col. 3, lines 54-59).

15. Schmidle et al. further teaches wherein a plastic layer is gelled (col. 6, line 39, col. 7, line 67).

16. It would have been obvious to one of ordinary skill in the art at the time of the invention to gel the plastic layer of Wang et al. for easier handling and processing (col. 7, line 67-col. 8, line 34).

17. Wang et al. as modified by Eby et al. and Schmidle et al. teaches a surface covering (Wang et al., See Title) wherein the portion of the cured coating or cured layer, which is not disposed over the ink, is embossed with a texture different from the embossed portion of the cured coating disposed over the ink, given that with the inclusion of the photoinitiator of Schmidle et al in the ink of Wang et al. the portion of the cured coating that is not disposed over the ink will have a texture different from the portion of the cured coating disposed over the ink (Schmidle et al., See Figure 4A).

18. The limitations "obtained by a method of making a surface covering…k. curing the second, curable coating" and "mechanically embossed" are process limitations. It is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process", *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

19. Therefore, absent evidence of criticality regarding the presently claimed process and given that Wang et al. as modified by Eby et al. and Schmidle et al. meets the requirements of the claimed surface covering, the prior art clearly meets the requirements of present claims. Furthermore, the claimed limitations of embossing are taught by the prior art, as disclosed above.

20. Regarding claim 22, Wang et al. teaches a surface covering (See Title) which comprises a substrate (felt layer 60, col. 9, lines 27-28), a foamed and chemically embossed plastic layer overlaying the substrate (foamed layer 62, col. 9, line 29-30, col. 10, lines 31-39), an ink printed in a design on said foamed plastic layer (printing design 64, col. 9, line 41, Fig. 10), and a non cured coating overlaying the foamed plastic layer and the ink (second layer 66, col. 9, lines 64-65, Fig. 10).

21. Wang et al. fails to teach a cured coating or cured layer overlaying the non-cured coating.

22. However, Eby et al. teaches a surface covering (See Title) wherein the portion of the cured coating or layer overlaying an ink is chemically and/or mechanically embossed (col. 3, lines 46-62 and 35-39).

23. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a cured coating overlaying the non-cured coating of Wang et al. to further protect underlying layers.

24. Wang et al. fails to teach an ink containing a photoinitiator.

25. However, Schmidle et al. teaches a surface covering (See Title) comprising an ink containing a photoinitiator (col. 9, lines 3-8, col. 12, lines 1-4, col. 3, lines 54-62).

26. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a photoinitiator in the ink of Wang et al. to create surface areas with an embossed flat, dead, or dull mat finish or texture (Schmidle et al, col. 3, lines 54-59).

27. Limitations regarding "chemically embossed" and “mechanically embossed” are process limitations. It is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

28. Therefore, absent evidence of criticality regarding the presently claimed process and given that Wang et al. as modified by Eby et al. and Schmidle et al. and meets the requirements of the claimed surface covering, the prior art clearly meets the requirements of present claims. Furthermore, the recited limitations are taught by the prior art, as disclosed above.

29. Regarding claim 23, Wang et al. teaches a surface covering (See Title) wherein the ink also contains an inhibitor (col. 9, lines 51-61).

30. Regarding claim 25, Wang et al. fails to teach wherein the cured coating or cured layer further comprising comprises a polyurethane coating.

31. However, Eby et al. teaches a surface covering (See Title) wherein a cured layer (wear layer, col. 5, lines 21-24) further comprising comprises a polyurethane coating (top coat, col. 8, lines 9-13).

32. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a polyurethane coating in the cured coating or layer of Wang et al. to provide surface gloss or shine (Eby et al., col. 10, lines 19-22).

Response to Arguments

33. Applicants' arguments filed 02 August 2010 have been fully considered but they are not persuasive.

34. Applicants added new claim 26.

35. Applicants argue that Wang does not teach that transparent or translucent layer 16 is non-curable and further "describes the first layer containing platey material as being 'hardenable'".

36. However, while something curable may be hardenable, it does not necessarily follow something hardenable has to be curable. That is, something curable can be hardened by something besides curing. Further, given that the non curable coating of Wang is made from plastisol which is identical to the material of the non curable coating, as presently claimed, it is clear that the coating of Wang made from plastisol is inherently non curable.

37. Applicants argue that "Examiner has apparently and improperly replaced claimed phrase 'non-curable' with the unclaimed phrase 'non-cured'" and that "Examiner has not indicated what relationship the Eby ink has to Wang…" and if the Eby ink or Eby print layer B is comparable with the cured coating of Wang.

38. However, it is agreed that Examiner inadvertently stated "cured" and "non-cured" in paragraphs 5 and 7 of the previous Office Action. However, Examiner meant "non-curable". Given that the rejection was drawn to claim 21, it is clear Examiner was referring to the claimed non-curable coating. Therefore, with respect to Eby, Examiner is not teaching to replace the cured-coating of Wang et al. since Wang et al. does not teach such coating but rather to use the cured coating of Eby overlaying the non-curable coating of Wang et al. to meet the present claims.

39. Applicants argue that Eby is silent as to the print layer B being non-curable.

40. Firstly, it is noted that Eby applies a cured coating over ink (col. 3, lines 46-62 and 35-39) which appears to be non-curable, but even if Eby does not teach a non-curable layer, note that while Eby does not disclose all the features of the present claimed invention, Eby is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226

(CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely a cured coating to further protect underlying layers, and in combination with the primary reference, discloses the presently claimed invention.

41. Applicants argue that "Examiner has not put forward any evidence that Want, Eby, or Schmidle disclose jointly or separately the claimed activating of the photo-initiator or the claimed mechanical embossing of the second layer in areas not overlapping the printing ink".

42. However, Schmidle et al. discloses that the photoinitiator is activated by ultra-violet radiation (col. 12, lines 1-4). With respect to the mechanical embossing, Wang et al. as modified by Eby et al. and Schmidle et al. teaches a surface covering (Wang et al., See Title) wherein the portion of the cured coating or cured layer, which is not disposed over the ink, is embossed with a texture different from the embossed portion of the cured coating disposed over the ink, given that with the inclusion of the photoinitiator of Schmidle et al in the ink of Wang et al. the portion of the cured coating that is not disposed over the ink will have a texture different from the portion of the cured coating disposed over the ink (Schmidle et al., See Figure 4A).

43. Applicants argue that “Eby fails to disclose a cured coating or a cured layer overlaying the non-cured coating, which is precisely the defect of Wang purportedly being cured by the Wang/Eby combination”.

44. It is agreed that Wang does not teach a cured layer, which is why Wang is used in combination with Eby. With respect to Eby, Eby is used as a teaching reference, as set forth above.

Conclusion

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

46. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

47. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1787

September 2, 2010

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787